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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/819,593 | 03/27/2001 | Kenneth Jenks | PALM-3583.US.P | 3487 |

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LEE, KYUNG S

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2832

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/819,593 | JENKS ET AL. |
| | Examiner | Art Unit |
| | Richard K. Lee | 2832 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 March 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-40 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Disposition of Claims

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 March 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 17 and 30 recite "a vertical cavity that is adapted to align." It has been held the recitation that an element is "adapted to" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchison, 69 USPQ 138.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Calandrello et al. (4,439,647).

Calandrello et al. teaches a button module for covering a button of a portable computing device, the module comprising:

a button frame module 3 (see fig. 12) with a vertical cavity aligned with the button 7;

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a membrane layer 4 disposed on an outer side of the button frame 3 and covering the opening; and

the button module covers the button of the portable computing device.

Regarding claim 9, Calandrello et al. teaches the frame module comprising of plastic (col. 4, line 18, Hawley's. page 975, rubber could be any number of synthetic polymer).

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 4-5, 8-9, 12-14, 17, 23-25, 28-30, 33-37 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Brick et al. (6,172,620).

Brick et al. teaches a button module comprising:

a button frame module 80 (see fig. 5) formed with a vertical cavity to align with the button 56;

a membrane layer 72 disposed on the outer side (reference 74) of the button frame 80 and covering the vertical cavity; and

the button module covers the button of the portable computing device.

Regarding claims 4-5 and 34, Brick et al. teaches the membrane layer 72 being composed of a flexible elastomer (col. 5, line 63). Elastomer (Hawley's Condensed Chemical Dictionary, page 437) includes silicone and rubber.

Regarding claims 8, 9, 12, 23-25, 28, 35-37 and 40, Brick et al. teaches the frame being comprised of plastic (col. 6, line 8). Further, plastic includes polycarbonate and nylon (Hawley's page 888).

Regarding claims 13, 14 and 29, Brick et al. teaches the button module removably coupled to a top cover 12 (fig. 5) of the personal digital assistant (PDA, col. 1, line 15).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-3, 6-7, 10-11, 18-22, 26-27, 31-32, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al. in view of Ohmae et al. (5,373,055).

Brick et al. teaches the claimed invention except for the membrane layer comprises a thermo-plastic elastomer (TPE) or thermo-plastic urethane (TPU). Ohmae et al. teaches the use of thermo-plastic elastomer for its flexibility as well as its excellent mechanical and thermal properties (col. 1, line 15). Ohmae et al. further teaches the use of thermo-plastic urethane as material that provides hard rubber or leather-like characteristics (col. 1, line 21).

One skilled in the art, at the time of the invention, would have found it obvious to provide the membrane layer of Brick et al. with either TPE or TPU of Ohmae et al. for the purpose of

providing a material which possesses flexibility as well as its excellent mechanical and thermal properties, and provides hard rubber or leather-like characteristics, respectively.

Regarding claims 6, 7, 22 and 23, Brick et al. and Ohmae et al. teach the claimed invention except for the membrane layer comprises a leather or nylon. It would have been an obvious engineering choice to use leather or nylon for the membrane layer since it appears that the invention would perform equally well with TPU, TPE, silicone and rubber.

Regarding claims 10-11, 26-27 and 38-39, Brick et al. and Ohmae et al. teach the claimed invention except for the frame module comprises a metal or an alloy. It would have been an obvious engineering choice to use a metal or an alloy for the for the frame module since it appears that the invention would perform equally well with plastic.

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al. Brick et al. teaches the claimed invention except for the button module coupled to a midframe or a rear cover of the PDA. It would have been an obvious engineering choice to couple the button module to the cover, the rear cover or the midframe of the PDA since it appears that the invention would perform equally well with by coupling to the cover as shown by Brick et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kimura, Sugiyama et al., Lima et al. and Wakefield teach button modules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard K. Lee whose telephone number is (703) 306-9060. The examiner can normally be reached on Mon. to Fri. 6:30AM to 3:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (703) 308-7619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Richard K. Lee
Examiner
Art Unit 2832



ELVIN ENAD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800


